

## REMARKS

### **I. Introduction**

Applicants and Applicants' representative would like to thank Examiner Huber for the indication of allowable subject matter recited by claim 9. In response to the Office Action dated March 30, 2005, Applicants have amended claims 1, 7 and 8 so as to further clarify the claimed subject matter. New claims 13 and 14 are added. Support for these amendments can be found, for example, in Fig. 1 and its corresponding section of the specification. No new matter has been added.

Furthermore, please note that Applicants will surrender the original ribboned copy of U.S. Patent No. 6,414,927 upon receiving a Notice of Allowance for the instant application.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

### **II. Status Of Claims**

Claims 1-14 are pending upon entry of this amendment.

Claims 1, 7 and 8 have been amended.

Claims 13 and 14 have been added.

Claim 1 has been amended to recite that the roller operates for a predetermined time after the pass of the disk being ejected is detected, where the predetermined time is based on the size of the disk. Support for the amendment to claim 1 can be found on col. 2, lines 2-14. Claim 8 has been amended in a manner similar to claim 1. Claim 7 has been amended so as to present the claim in a more grammatically correct manner. No new matter has been added. New claims 13 and 14 further clarify the operation of the roller and that the claimed device and method can be

utilized with different size disks. Support for new claims 13 and 14 can be found on col. 1, lines 40-44 and col. 2, lines 2-14.

**III. The Rejection Of Claims 1-8 and 10-11 Under 35 U.S.C. § 102**

Claims 1-8 and 10-11 are rejected under 35 U.S.C. §102(e) as being anticipated by JP 11-213503 to Takahiro. Applicants respectfully request reconsideration of this rejection for at least the following reasons.

Claim 1 recites in-part a controller for *storing a predetermined operation time* of said roller corresponding to the discriminated size, and for having said roller operate for the *predetermined operation time* after the pass of the disk being ejected is detected.

In the statement of rejection, it is alleged that if the disk is discriminated to be a large-diameter disk, the transportation means G is halted when the detecting means 35 is brought into a non-detecting state, and if the disk is discriminated to be a small-diameter disk, the transportation means G is halted when the detecting means 34 is brought into a non-detecting state (see, page 2 of Office Action).

However, it should be noted that the conveyance roller 22 of the transportation means G (see, [0019]) of Takahiro is activated/halted upon the detection of the ON/OFF condition of the detecting switches 34/35 (see, Fig. 11 and [0084] – [0085]), and is not activated/halted according to a predetermined operation time of the roller 22. This is supported by the fact that only after the edge Y2 of the major-diameter disk DL passes the 3<sup>rd</sup> detection switch 35 will the 3<sup>rd</sup> detection switch be turned from OFF to ON condition, at which point the conveyance roller 22 is suspended (see, Fig. 7 and [0074]). Similarly, the condition of the 2<sup>nd</sup> detection means 34 changes from ON to OFF after the minor diameter disk DS passes the 2<sup>nd</sup> detection switch 34,

and from OFF to ON after the minor diameter disk DS passes the 2<sup>nd</sup> detection switch 34 again, at which point the conveyance roller 22 is halted (see, Fig. 10 and [0084]). Accordingly, the conveyance roller 22 of Takahiro is not operated based on an operation time that is predetermined in advance. This is further evidenced by the fact that Takahiro does not disclose any means for storing any timing information relevant to the operation of the conveyance roller 22 or the transportation means G, let alone suggest operating the roller 22 for a predetermined time *after* detecting the passing of the disk. Accordingly, it is respectfully submitted that Takahiro does not disclose or suggest “storing a predetermined operation time of said roller corresponding to the discriminated size, and for having said roller operate for the predetermined operation time after the pass of the disk being ejected is detected,” as recited by claim 1.

In contrast to Takahiro, the present invention as recited in claim 1 embodies storing a predetermined operation time of the roller based on the size of the disk, and operating the roller based on this operation time after detecting the passing of the disk being ejected. For instance, according to one exemplary embodiment of the present invention, when a small diameter disk is ejected, the roller is not immediately stopped after the detection thereof. Rather, the roller is continuously driven for a certain time until the small diameter disk reaches a predetermined distance (see, col. 2, lines 1-6 of USP No. 6,414,927).

With respect to claim 8, as this claim also recites the claimed feature “storing a predetermined operation time corresponding to the discriminated size, and having the roller operate for the predetermined operation time of ejecting the disk,” it is respectfully submitted that claim 8 is patentable over Takahiro for reasons at least the same reasons as discussed above respect to claim 1.

As anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Takahiro fails to disclose or suggest the foregoing claim elements recited by claim 1 and 8, it is clear that Takahiro does not anticipate claim 1 or 8, or any of the claims dependent thereon.

**IV. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

**V. Conclusion**

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

**Application No.: 10/607,528**

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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